

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))REMARKS

Claim 1-6, 8-14 and 16-20 are pending in this case. In the section above, claims 1, 8-9, 17 and 19-20 have been amended; claims 16 and 18 have been cancelled. Based on the following remarks, it is respectively submitted that claims 1-6, 8-14, 17 and 19-20 are allowable.

Amendments to Claims

Claim 1 has been amended to indicate the controlled nature of the wireless device in the method for utilizing an interface client in an interface roaming network. As amended, the method requires a user-driven wireless device under the direct and physical control of a user where the wireless device presents data to an interface client for display. (*See e.g.*, p. 5, ll. 1-24). For purposes of example, a user may input information to the wireless device in response to generated content displayed on an interface client. (p. 8, ll. 16-17). Claim 8 has been amended to restate the claimed subject matter in an active tone of voice (i.e., from "wherein the content is formatted" to "formatting the content").

Claim 9 has been amended to incorporate the subject matter generally claimed in cancelled claim 16. Claim 9 presently includes limitations directed at the ability of one of the interface client, the wireless device and the remote source to format the content based on the submitted information from the interface client. (p. 13, ll. 11-17).

Claim 17 has been amended to recite a computer program stored in a tangible medium in accordance with *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). In addition, claim 17 has been amended to include the type of information submitted by the interface client and the ability of the program to recognize the content received by the interface client as data from a remote source. Claims 19

11602.00.0005  
CHICAGO/#1423391.2

7

09/695,518

PATENT

AMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))

and 20 are amended to properly depend from claim 17.

It is recognized that the amendments made in claims 1, 9, 17 and 19-20 serve to either clarify the claimed subject matter in accordance with the written description or merely update terminology for purposes of advancing prosecution. The amendments do not add new matter.

#### § 101 Rejection of Claims

Claims 17-20 were rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. This rejection is respectfully traversed in light of the amended claims which, among other things, recite statutory subject matter.

As stated *In re Beauregard*, "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103." 53 F. 3d 1583. As presently submitted, claim 17 provides for a "computer program product . . . comprising . . . a computer usable medium having . . . (a) computer readable program code for submitting information . . . (b) computer readable program code for receiving content and recognizing the content as data from a remote source; and (c) computer readable program code for displaying the content . . . ." (Emphasis added). Claim 18 is cancelled and claims 19-20 have been amended to properly depend from claim 17. Because the rejected claims have been amended such that the computer program product is tangibly embedded in an appropriate manner, the rejection should be withdrawn.

#### § 102 Rejection of Claims

Claims 1-6, 8-14, 17 and 19-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kobayashi, U.S. Patent No. 6,633,759 ("Kobayashi"). This rejection is respectfully traversed and it is submitted that these claims recite subject

11602.00.0005  
CHICAGO/#1423391.2

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))

matter which is not anticipated by and is patentable over Kobayashi.

Claims 1-6 and 8

It appears that Kobayashi is directed to, among other things, a mobile communication device such as a cellular phone and an external device such as personal computer (FIGs. 1, 9 and 12). In one embodiment, Kobayashi teaches that a user may manipulate a cellular phone to start software installed on the PC and subsequently display the result on the cellular phone. (See Abstract, Fig. 9). In this embodiment, the cellular phone is at the user's hand – i.e., the user physically interacts with the cellular phone – and the PC's software is indirectly controlled by the cellular phone to execute and return display data to the user-driven cellular phone.

In another embodiment, Kobayashi teaches that the process is reversed. With reference to FIG. 12, a user-driven PC is controlled to wirelessly connect with an externally-located cellular phone (e.g., in a pocket or briefcase). After connecting with the cellular phone, the PC runs software on the cellular device and display information is returned to the PC for display at the user. In one instance, the PC starts an e-mail program on the cellular phone, confirms the mail data obtained by the e-mail function, and displays the data on the screen of the PC. (col. 13, l. 12 - col. 14, l. 6). In this second embodiment, the user physically interacts with the PC. The user has no direct or physical interaction with the cellular phone.

It is submitted that claim 1 requires among other things, a user-driven wireless device that receives along a second wireless communication path content from a remote source and conveys the content to the interface client along the first wireless communication path. In other words, claim 1 requires three devices - a remote source, an interface client and a wireless device - where the wireless device

11602.00.0005  
CHICAGO/1423391.2

9

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))

is user-driven (i.e., resides at the user and is under the user's direct and physical control) and "sits" between the remote source and the interface client for purposes of receiving and conveying information. Finally, content is displayed on the interface client.

To the extent that Kobayashi can be compared to claim 1, it is recognized that neither embodiment of Kobayashi anticipates Applicants' claim 1. For instance, Kobayashi's first embodiment requires the display of data on a user-driven cellular phone physically located at the user's hands where the display data is from a remotely-located and non-user-driven PC and where only the cellular phone is capable of communication with a remote tower/server or other remote device as a potential source of the display data (FIGs. 1 and 9). To the extent that Kobayashi's first embodiment can be compared to claim 1, the Office action must be interpreted as associating the cell phone to the claimed interface client because only the cell phone in Kobayashi's first embodiment displays data. As a matter of consequence, the Office action must be interpreted as associating the PC to the claimed user-driven wireless device. However, this comparison cannot stand because, among other things, Kobayashi's PC is neither user-driven or capable of conveying content from a remote source to the cell phone. Therefore, Kobayashi's first embodiment cannot be said to anticipate Applicants' claim 1.

Moreover, Kobayashi's second embodiment also fails to teach the method of claim 1. For instance, the second embodiment requires the display of data on a user-driven PC physically located at the user's hands where the display data is conveyed from a remotely-located and non-user-driven cellular phone and where only the cellular phone is capable of communication with a remote tower/server or other remote device as the potential source of the display data (FIG. 12). To the extent that Kobayashi's second embodiment can be compared to claim 1, the Office action must be interpreted as associating the PC to the claimed interface

11602.00.0005  
CHICAGO/#1423391.2

10

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))

client because only the PC in Kobayashi's second embodiment displays data. As a matter of consequence, the Office action must be interpreted as associating the cellular phone to the claimed user-driven wireless device. However, this comparison cannot stand because, among other things, Kobayashi's cellular phone is not user-driven as required by claim 1. Therefore, Kobayashi's second embodiment cannot be said to anticipate Applicants' claim 1.

For the aforementioned reasons, claim 1 is in proper condition for allowance. Claims 2-6 and 7 depend from allowable claim 1 and further add novel and patentable subject matter. Allowance of claims 2-6 and 7 is earnestly solicited.

Claims 9-14

The relevant remarks stated above with respect to claim 1 are respectfully repeated with respect to claim 9. Additionally, it is respectfully submitted that in contrast to the Office action's assertions, Kobayashi does not appear to teach or suggest formatting content for display based on the submitted information from the interface client. For instance, it is respectfully recognized that column 12, lines 22-32 of Kobayashi, while cited by the Office action as teaching the claimed subject matter, merely illustrates that in Kobayashi's second embodiment (where data is displayed on the PC), the PC can determine if a user has selected which software to execute on the cellular phone. If a user has made a selection (a manipulation) the selected software request is sent in real time to the cellular phone and screen data corresponding to the selected software is sent from the cellular phone to the PC.

Moreover and as explained above, Kobayashi's first embodiment requires the display of data on a user-driven cellular phone which is capable of direct communication with a remote tower/server and therefore is not properly comparable to claim 9 for purposes of anticipation. Only Kobayashi's second embodiment, where data is displayed on the PC and where the cellular phone is

11602.00.0005  
CHICAGO/#1423391.2

11

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))

capable of communication with both the PC and the remote tower/server, may be considered under 35 U.S.C. § 102. To this end, Kobayashi does not appear to teach the adaptation of one of the interface client (ostensibly, the PC), the wireless device (ostensibly, the cellular phone) and the remote source (ostensibly, the remote tower/server) to format the content based on the submitted information from the interface client.

In addition to Kobayashi's apparent silence with respect to formatting by one of the above-claimed devices, Kobayashi further appears to be silent with respect to the interface client (ostensibly, the PC) submitting information to a wireless device where at least some of the submitted information is used to format content for display. In contrast, the information exchanged between the PC and cellular phone appears to be limited to identification information in a link request signal and other information necessary to establish a wireless link between the two devices. (See *e.g.*, col. 11, l. 67 – col. 12, l. 2).

For the aforementioned reasons, claim 9 is in proper condition for allowance. Claims 10-14 depend from allowable claim 9 and further add novel and patentable subject matter. Allowance of claims 9-14 is earnestly solicited.

Claims 17 and 19-20

The relevant remarks made above with respect to claim 9 are respectfully repeated with respect to claim 17. Specifically, it is recognized that only Kobayashi's second embodiment is relevant when comparing the reference's teachings to the claimed subject matter of the present application.

It is further recognized that the Kobayashi fails to teach a computer program comprising a computer usable medium having code for submitting information about an interface client (ostensibly, the PC) to a wireless device

11602.00.0005  
CHICAGO/#1423391.2

12

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))

(ostensibly, the cellular phone) “wherein the information about the interface client includes at least one of: information about the capabilities of the interface client, information about the display capabilities of the interface client, information about an input device of the interface client, and information about the location of the interface client.” (Emphasis added). In contrast, the information exchanged between the PC and cellular phone in Kobayashi’s second embodiment appears to be limited to identification information in a link request signal and other information necessary to establish a wireless link between the two devices. (*See e.g.*, col. 11, l. 67 – col. 12, l. 2).

For the aforementioned reasons, claim 17 is in proper condition for allowance. Claims 19-20 depend from allowable claim 9 and further add novel and patentable subject matter. Allowance of claims 17 and 19-20 is earnestly solicited.

11602.00.0005  
CHICAGO/#1423391.2

13

09/695,518

PATENTAMENDMENT C (IN RESPONSE TO PAPER NO. 051905  
(OFFICE ACTION DATED JUNE 1, 2005))Conclusion

In light of the present amendments, claims 1-6, 8-14, 17 and 19-20 remain pending in this case. Based upon the foregoing remarks, it is respectfully submitted that these claims are allowable, and reconsideration and early allowance of these claims are requested.

Date: Oct. 17, 2005

Respectfully submitted,

VEDDER, PRICE, KAUFMAN &  
KAMMHOLZ, P.C.By: Mark A. Dalla Valle  
Reg. No. 34,147

Attorney for Assignee  
222 N. LaSalle St.  
Chicago, IL 60601  
Telephone: 312-609-7500  
Facsimile: 312-609-5005  
Customer No. 23418  
Atty. Docket: 11602.00.0005

11602.00.0005  
CHICAGO/#1423391.2

14